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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/083,793 05/22/98 MURPHY

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EXAMINER

MOSHER, M

ART UNIT

PAPER NUMBER

1643

7


DATE MAILED:

04/23/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No. <b>09/083,793</b>	Applicant(s) <b>Murphy et al</b>	
Examiner <b>Mosher</b>	Group Art Unit <b>1643</b>	

☒ Responsive to communication(s) filed on 1/26/99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-94 and 96-143 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-94 and 96-143 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

On reconsideration, applicant's arguments are convincing that the groups of claims should be examined together, as the groups are not so distantly related that search and examination of inventions I-III could not be made without serious burden. On reconsideration, the serious burden lies in the number of distinct species recited in the large number of claims. Therefore, the previous restriction requirement is withdrawn, and election of species is now required.

This application contains claims directed to the following patentably distinct species of the claimed invention:

1. Chimeric PIV comprising sequences from two different species of PIV
2. Chimeric virus comprising sequences from PIV and another paramyxovirus
3. Mutated PIV with attenuated phenotype
4. Mutated PIV with ts phenotype
5. Mutated PIV with cold-adapted phenotype
6. Mutated PIV with small plaque phenotype
7. Mutated PIV with host range phenotype
8. Mutated PIV with altered epitope phenotype
9. Mutated PIV with alteration in L protein
10. Mutated PIV with alteration in N protein
11. Mutated PIV with alteration in C protein
12. Mutated PIV with alteration in F protein
13. Mutated PIV with alteration in HN protein
14. Mutated PIV with alteration in 3' leader sequence
15. Mutated PIV with alteration in N gene start sequence
16. PIV vector comprising sequence encoding cytokine
17. PIV vector comprising sequence encoding T-helper epitope
18. PIV vector comprising sequence encoding immunoprotective microbial protein
19. Mutated PIV with restriction site marker
20. Mutated PIV with one or more mutations incorporated from specifically named mutant strains

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 11, 48-61, 91-93, and 118-120 are generic.

The species are seen as patentably distinct, because the species involve viruses with materially different characteristics such as different phenotypic properties and different genomic sequences, with materially different utilities; the search required for each species diverges from the search required for the other species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, ***and a listing of all claims readable thereon, including any claims subsequently added.*** An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. ***If claims are added after the election, applicant must indicate which are readable upon the elected species.*** MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is (703) 308-2926. The examiner can normally be reached on Monday -Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Eisenschenk, can be reached on (703) 308-0452. The fax phone number for this Group is now (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196 .

April 22, 1999

*Mary Mosher*  
MARY E. MOSHER  
PRIMARY EXAMINER  
GROUP 1600  
1600